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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,699	02/14/2001	Manuel Enrique Benitez	OMNI0002	3149

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EXAMINER
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EL CHANTI, HUSSEIN A

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 10/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/784,699

Applicant(s)

BENITEZ ET AL.

Examiner

Hussein A. El-chanti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

1. This action is responsive to amendment received on Sep. 7, 2005. Claims 1-45 are pending examination.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4, 11-14, 16-19, 26-29, 31-34 and 41-44 are rejected under 35 U.S.C. 102(e) as being anticipated by Eylon et al., U.S. Patent No. 6,757,894 (referred to hereafter as Eylon).

Eylon teaches the invention explicitly as claimed including a system and method installing software application on a client computer by streaming application packages to the client computer (see abstract).

As to claims 1, 16 and 31, Eylon teaches a process, apparatus and program storage medium respectively for intelligent server streaming of conventionally coded application programs across a computer network while concurrently executing said application programs on a client in a computer environment, comprising the steps of:

Downloading an initial portion of a streamed application program on said client wherein said streamed application program comprises page segments and wherein said

initial portion of said streamed application remains on said client after terminating execution of said streamed application by said client (see col. 7 lines 62-col. 8 lines 6, server streams blocks that are necessary to start execution of the application while additional packages are being downloaded);

providing an application server; partitioning said application program into appropriate page segments on said application server (see col. 6 lines 29-47, application is divided into blocks);

wherein said application server streams said page segments to said client upon said client's request (see col. 6 lines 48-65);

wherein the user starts said application program in the same manner as if said application program were fully installed on said client (see col. 7 lines 62-col. 8 lines 6, server streams blocks that are necessary to start execution of the application while additional packages are being downloaded);

wherein specific page segments are requested by said client's file system during execution of said application program such that said streamed application program begins execution on said client prior to downloading all of said page segments (see col. 7 lines 62-col. 8 lines 6);

and storing said page segments in a cache on said client (see col. 7 lines 62-col. 8 lines 6).

As to claims 2, 17 and 32, Eylon teaches the process, apparatus and program of claims 1, 16 and 31 respectively, wherein said application program is not recompiled, rewritten, or rebuilt for this specific delivery mechanism (see col. 7 lines 62-col. 8 lines 6).

As to claims 3, 18 and 33, Eylon teaches the process, apparatus and program of claims 1, 16 and 31 respectively, wherein said client manages said cache by purging page segments that are stale or not needed (see col. 7 lines 39-67).

As to claims 4, 19 and 34, Eylon teaches the process, apparatus and program of claims 1, 16 and 31 respectively, wherein said client does not request page segments of said application program that already reside in said cache (see col. 7 lines 39-67).

As to claims 11, 26 and 41, Eylon teaches the process, apparatus and program of claims 1, 16 and 31 respectively, further comprising the step of: providing a profile information database characterizing the typical page segment needs of each application program on said application server (see col. 6 lines 29-47).

As to claims 12, 27 and 42, Eylon teaches the process, apparatus and program of claims 1, 16 and 31 respectively, wherein said profile information database is updated dynamically as page segments are requested from said application server (see col. 6 lines 49-57).

As to claims 13, 28 and 43, Eylon teaches the process, apparatus and program of claims 1, 16 and 31 respectively, wherein said client prefetches page segments of

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said application program from said application server based on the profile information of said application program (see col. 7 lines 62-col. 8 lines 6).

As to claims 14, 29 and 44, Eylon teaches the process, apparatus and program of claims 1, 16 and 31 respectively, wherein said application server pushes page segments of said application program to said client based on the profile information of said application program (see col. 7 lines 62-col. 8 lines 6).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 5-9, 20-24 and 35-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eylon in view of Franco et al., U.S. Patent No. 6,687,745 (referred to hereafter as Franco).

As to claims 5, 20 and 35, Eylon teaches a process, apparatus and program storage medium respectively for intelligent server streaming of conventionally coded application programs across a computer network while concurrently executing said application programs on a client in a computer environment.

Eylon does not explicitly teach the limitation “ providing a subscription server; and wherein the user subscribes or unsubscribes to application programs with said subscription server”.

However Franco teaches a system and method including an application server where a user subscribes with a registration server to download and use software applications stored on the application server (see abstract).

It would have been obvious for one of the ordinary skill in the art at the time of the invention to modify Eylon by incorporating the subscription server because doing so would allow users to customize the retrieval and display of the requested application programs as taught by Franco (see col. 25 lines 28-65).

As to claims 6, 21 and 36, Franco teaches the process, apparatus and program of claims 1, 16 and 31 respectively, further comprising the step of: providing a license server; and wherein said client obtains an access token for a requested application program from said license server if the user has a valid subscription to said requested application program (see col. 25).

As to claims 7, 22 and 37, Franco teaches the process, apparatus and program of claims 6, 21 and 36 respectively, wherein said access token contains an expiration tag (see col. 26 lines 23-37).

As to claims 8, 23 and 38, Franco teaches the process, apparatus and program of claims 6, 21 and 36 respectively, wherein said access token is securely encrypted (see col. 25).

As to claims 9, 24 and 39, Franco teaches the process, apparatus and program of claims 6, 21 and 36 respectively, wherein said client passes said access token to said application server before requesting page segments of said application program (see col. 5).

4. Claims 10, 15, 25, 30, 40 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eylon in view of Oehrke et al., U.S. Patent No. 6,735,631 (referred to hereafter as Oehrke).

As to claims 10, 25 and 40, Eylon teaches a process, apparatus and program for intelligent server streaming comprising installing a portion of an application program on said client and providing an application server (see the rejection of claims 1, 16 and 31 respectively).

Eylon does not explicitly teach the limitation "if said license server fails said client automatically switches to another license server". However Oehrke teaches a load balancing method and system where if a server fails, the system selects another server to provide the requested content (see abstract).

It would have been obvious for one of the ordinary skill in the art at the time of the invention to modify Eylon by incorporating the step of switching to another server in case of a failure as taught by Oehrke because doing so would make the system more efficient where the network of service providers always running even in the case of a server failure.



As to claims 15, 30 and 45, Oehrke teaches the process, apparatus and program performs load balancing among a plurality of application servers for page segment requests (see abstract).

### **Affidavit**

5. The affidavit filed on Sep. 7, 2005 is insufficient to overcome the rejection of claims 1-4, 11-14, 16-19, 26-29, 31-34 and 41-44 over Eylon under 35 USC 102(e) as set forth in the last office action dated March 7, 2005 because it is not properly executed and fails to establish reduction to practice prior to the date of the reference.

I. The affidavit is ineffective because it was not properly executed. It was not signed by all inventors.

The following parties may make an affidavit or declaration under 37 CFR 1.131:

- (A) All the inventors of the subject matter claimed.
- (B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted where it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection.
- (C) If a petition under 37 CFR 1.47 was granted or the application was accepted under 37 CFR 1.42 or 1.43, the affidavit or declaration may be signed by the 37 CFR 1.47 applicant or the legal representative, where appropriate.

(D) The assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor. Ex parte Foster, 1903 C.D. 213, 105 O.G. 261 (Comm'r Pat. 1903).

Affidavits or declarations to overcome a rejection of a claim or claims must be made by the inventor or inventors of the subject matter of the rejected claim(s), a party qualified under 37 CFR 1.42, 1.43, or 1.47, or the assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor(s). Thus, where all of the named inventors of a pending application are not inventors of every claim of the application, any affidavit under 37 CFR 1.131 could be signed by only the inventor(s) of the subject matter of the rejected claims. Further, where it is shown that a joint inventor is deceased, refuses to sign, or is otherwise unavailable, the signatures of the remaining joint inventors are sufficient. However, the affidavit or declaration, even though signed by fewer than all the joint inventors, must show completion of the invention by all of the joint inventors of the subject matter of the claim(s) under rejection. In re Carlson, 79 F.2d 900, 27 USPQ 400 (CCPA 1935).

II. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Eylon reference to either a constructive reduction to practice or an actual reduction to practice.

The evidence submitted does not show a timeline between the date of the conception the date of reduction to practice "Nov. 6, 2000".

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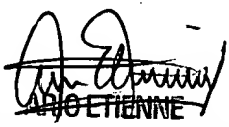
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hussein A. El-chanti whose telephone number is (571)272-3999. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571)272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hussein El-chanti

Sep. 27, 2005

  
ARIO ETIENNE  
SUPERVISORY PATENT EXAMINER  
SEP 27 2005